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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,168	11/06/2001	Merrit N. Jacobs	CDS-256	8482
27777	7590	12/28/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			DAVIS, DEBORAH A	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,168

Applicant(s)

JACOBS ET AL.

Examiner

Deborah A Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3 are drawn to a method of mixing a plurality of liquids comprising an improvement wherein the capillary number resulting from the mixing in said step c) does not exceed about 0.01, wherein the capillary number being defined as the ratio of liquid velocity times viscosity and surface tension, so that any tails formed during said mixing step c) are minimized, classified in class 436, subclass 173.
 - II. Claims 4-10 are drawn to a method of mixing a plurality of liquids comprising an improvement of cavity parts comprise two separate but matable tip portions, classified in class 435, subclass 286.5.
 - III. Claims 11-12 are drawn to a method of mixing a plurality of liquids comprising a probe tip with an internal cavity having a cross-sectional flow-through area, classified in class 435, subclass 286.4.
 - IV. Claim 13, drawn to a method of mixing a plurality of liquids comprising a probe tip comprising a joining collar mounted around tip portion of probe, classified in class 436, subclass 177.
 - V. Claims 14-15 are drawn to a method of mixing a plurality of liquids comprising a probe tip comprising an inside cavity with a large inside diameter greater than the height of the total moved liquid, but less than

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twice the height of the total liquid moved so that mixing is maximized, classified in class 436, subclass 175.

- VI. Claims 16-17 are drawn to a method of mixing a plurality of liquids comprising a probe tip having an internal cavity of a large diameter located at opposite ends of cavity part of small diameter, classified in class 435, subclass 288.5.
- VII. Claims 18-20 are drawn to an apparatus comprising a probe tip with a wall defining 3 connected cavities of unequal inside diameters, classified in class 435, subclass 288.6.
- VIII. Claims 21-25 are drawn to a method of determining the strength agglutination, classified in class 435, subclass 7.92.
- IX. Claims 26-29 are drawn to a method of agglutination comprising scanning the liquid within a cavity of a container with a beam of light at predetermined wavelengths, classified in class 436, subclass 173.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I-VI and VIII-IX are unrelated methods. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The instant methods are distinct because they include different standards of

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improvement. Group 1 requires mixing a plurality of liquids comprising an improvement wherein the capillary number resulting from the mixing in said step c) does not exceed about 0.01, wherein the capillary number being defined as the ratio of liquid velocity times viscosity and surface tension, so that any tails formed during said mixing step c) are minimized. Group II requires mixing a plurality of liquids comprising an improvement of cavity parts that include two separate but matable tip portions. Group III requires mixing a plurality of liquids comprising a probe tip with an internal cavity having a cross-sectional flow-through area. Group IV requires mixing a plurality of liquids comprising a probe tip comprising a joining collar mounted around tip portion of probe. Group V requires mixing a plurality of liquids comprising a probe tip comprising an inside cavity with a large inside diameter greater than the height of the total moved liquid, but less than twice the height of the total liquid moved so that mixing is maximized. Group VI requires mixing a plurality of liquids comprising a probe tip having an internal cavity of a large diameter located at opposite ends of the cavity part of small diameter. Group VIII requires a method of determining the strength of an agglutination assay. Group IX requires a method of agglutination that include a step of scanning a liquid within a cavity of a container with a beam of light at predetermined wavelengths. Each of the methods above are patentably distinct one from the other because the process of each method include steps that are not required by the other.

3. Inventions VII and (I-VI and VIII-IX) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as

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claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of Group VII can be used to practice any of the distinct methods of Groups (I-VI and VIII-IX).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Please note that classifications in the restriction are illustrative only and do not represent all the classes and subclasses which must be searched for each invention; nor is the search limited to issued US patents, but rather includes foreign patents and applications as well as literature searches, therefore restriction for examination purposes as indicated proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

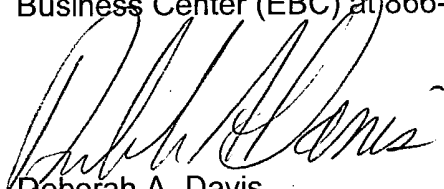
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

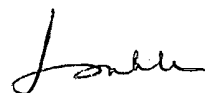
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A Davis whose telephone number is (571) 272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah A. Davis
Remsen Bldg.
November 30, 2004


LONG V. LE
SUPERVISORY PATENT EXAMINER
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12/26/04